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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/687,208 | 10/16/2003 | Jeffrey N. Johnston | 47524-293307 | 8224 |

7590 04/27/2004

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EXAMINER

AULAKH, CHARANJIT

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1625

DATE MAILED: 04/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/687,208

Applicant(s)

JOHNSTON ET AL.

Examiner

Charanjit S. Aulakh

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 72-75 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 72-75 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. According to a preliminary amendment filed on Oct. 16, 2003, the applicants have canceled claims 1-71 and furthermore, have added new claims 72-75.
2. Claims 72-75 are now pending in the application.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 72-75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In independent claim 72, the value of variables R, R1, R2 and R3 defined as ---heteroaryl---is indefinite since the size of the ring, number and types of heteroatoms present in the ring are not defined. Also, the term --hydrocarbyl--is vague. Does it mean alkyl or something else?

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 72 and 73 are rejected under 35 U.S.C. 102(b) as being anticipated each by Boie (Synthesis), O'Donnell (Tetrahed. Asymmetry), Crisp (Tetrahed. Lett.) and Sames (J. Org. Chem.).

Boie discloses stereoselective synthesis of enantiopure beta-amino alcohols. The compound no. 10 (see scheme 2 on page 177) disclosed by Boie anticipates the

Art Unit: 1625

instant claims when both R1 and R2 represent phenyl groups in the instant compounds of formula of claim 72.

O'Donnell discloses Preparation of optically active beta-carboxyaspartic acid derivatives. The compound no. 7 (see page 623) disclosed by O'Donnell anticipates the instant claims when both R1 and R2 represent phenyl groups in the instant compounds of formula of claim 72.

Crisp discloses Accelerated transmetallation in stille couplings. The compound 3a (see page 3390) disclosed by Crisp anticipates the instant claims when both R1 and R2 represent phenyl groups in the instant compounds of formula of claim 72.

Sames discloses Preparation of monosilyl acetals from esters. The compounds 5h, 5i, 6h and 6i (see table 3 on page 2155) anticipate the instant claims when both R1 and R2 represent phenyl groups in the instant compounds of formula of claim 72.

Claims 72 and 73 are also anticipated by compounds, RN 161300-04-5 (Compound no. 17 disclosed in Monatshefte fur Chemie, vol. 125 (11), page 1160, 1994) ; RN 126385-60-2 (compound no. 6d disclosed in Tetrahedr. Lett. Vol. 30(30) page 3964, 1989) ; RN 31025-83-9 (compound no. 32 disclosed in J. of Economic Entomology, Vol. 63(6) page 1859, 1970) when R1 and R2 represent either alkyl or phenyl groups in the instant compounds of formula of claim 72.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 72-75 are rejected under 35 U.S.C. 102(a) as being anticipated by compound, RN 352311-16-1 (disclosed in Organic Lett. Vol. 3 (13), pages 2045-2048, 2001).

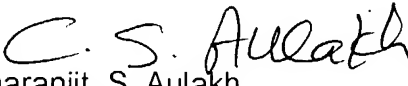
Art Unit: 1625

Compound, RN 352311-16-1 anticipates the instant claims when both R1 and R2 represent methyl groups and n represents 0 in the instant compounds of formula of claim 72.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charanjit S. Aulakh whose telephone number is (571)272-0678. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571)272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Charanjit S. Aulakh
Primary Examiner
Art Unit 1625